

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
Attorney Docket No.: 14446US02**

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| In the Application of: |) | |
| |) | |
| Jeyhan Karaoguz, et al. |) | <u>Electronically Filed On February 17, 2011</u> |
| |) | |
| Serial No.: 10/672,664 |) | |
| |) | |
| Filed: September 26, 2003 |) | |
| |) | |
| For: MEDIA EXCHANGE NETWORK |) | |
| SUPPORTING DELIVERY OF MEDIA |) | |
| CONTENT TO AUTHORIZED |) | |
| VEHICLES VIA MEDIA |) | |
| PROCESSING SYSTEM |) | |
| |) | |
| Examiner: Luong, Alan H. |) | |
| |) | |
| Group Art Unit: 2427 |) | |
| |) | |
| Confirmation No.: 9798 |) | |

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-7, 9-18, 20-34, and 36-61 of the present application. The Applicants request a one-month extension of time in which to respond. Thus, the period for reply runs until March 1, 2011, which is three months from the December 1, 2010 Notice of Appeal.

REAL PARTY IN INTEREST
(37 C.F.R. § 41.37(c)(1)(i))

The real party in interest is Broadcom Corporation, a corporation organized under the laws of the state of California, having a place of business at 5300 California Avenue, Irvine, California 92617, which has acquired the entire right, title and interest in and to the invention, the application, and any and all patents to be obtained therefor, as set forth in the Assignment recorded at Reel 014255, Frame 0553 in the PTO Assignment Search room.

RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(c)(1)(ii))

The following appeals may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal:

- U.S. App. No. 10/672,654, filed September 26, 2003
- U.S. App. No. 10/675,467, filed September 30, 2003
- U.S. App. No. 10/675,057, filed September 30, 2003
- U.S. App. No. 10/675,358, filed September 30, 2003
- U.S. App. No. 10/675,491, filed September 30, 2003
- U.S. App. No. 10/675,436, filed September 30, 2003

As of the filing date of this Appeal Brief, the Applicants are not aware of any decisions that have been rendered with respect to any of the Appeals noted above.

STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

The present application includes claims 1-7, 9-18, 20-34, and 36-61, all of which stand rejected. Claims 8, 19, and 35 were canceled without prejudice or disclaimer.¹ The Applicants identify claims 1-7, 9-18, 20-34, and 36-61 as the claims that are being appealed. The text of the claims involved in this Appeal is provided in the Claims Appendix.

STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(c)(1)(iv))

Subsequent to the final rejection of claims 1-7, 9-18, 20-34, and 36-61 mailed September 1, 2010, the Applicants filed a Second Notice of Appeal and Second Pre-Appeal Brief Request for Review.² Note, in response to the First Notice of Appeal and First Pre-Appeal Brief Request for Review, the Panel reopened prosecution.³

Fourteen business days after the Applicants filed the Second Pre-Appeal Brief Request for Review, a Second Notice of Panel Decision from Pre-Appeal Brief Review was mailed.⁴ The Second Notice of Panel Decision from Pre-Appeal Brief Review indicates that the application should proceed to the Board of Patent Appeals and Interferences.⁵ Accordingly, the Applicants are submitting this Appeal Brief.

¹ See December 19, 2008 Amendment Under 37 C.F.R. § 1.114.

² See December 1, 2010 Second Notice of Appeal and Second Pre-Appeal Brief Request for Review.

³ See January 11, 2010 Notice of Panel Decision from Pre-Appeal Brief Review.

⁴ See December 21, 2010 Notice of Panel Decision from Pre-Appeal Brief Review.

⁵ See *id.* Note, the reviewing Panel consisted of only the Examiner and the Examiner's Supervisory Patent Examiner – the same Examiner and Supervisory Patent Examiner who signed the September 1, 2010 Final Office Action. See December 21, 2010 Notice of Panel Decision and September 1, 2010 Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(c)(1)(v))

Independent claim 1 recites the following:

1. A system providing support for the delivery of media to an authorized vehicle,⁶ the system comprising:

a storage for storing media,⁷ and having an associated first network address;⁸

set top box circuitry⁹ communicatively coupled to the storage,¹⁰ the set top box circuitry arranged to exchange media via a communication network using a first communication interface,¹¹ the set top box circuitry supporting wireless communication of media using a second communication interface,¹² the set top box circuitry being remotely located from the authorized vehicle;¹³

at least one vehicle system within the authorized vehicle remotely located from and communicatively coupled to the set top box circuitry via the second communication interface,¹⁴ the at least one vehicle system having an associated second network address,¹⁵ the at least one vehicle system comprising an entertainment system;¹⁶

a user interface¹⁷ to support the delivery of media,¹⁸ the user interface having at least one view comprising a representation of a sequence of media available for delivery to the at least one vehicle system,¹⁹ the at least one view comprising a first personal media channel that facilitates a

⁶ See present application at, for example, page 5, lines 2-12.

⁷ See *id.* at, for example, page 5, lines 3-4.

⁸ See *id.* at, for example, page 5, lines 5-6.

⁹ See *id.* at, for example, page 27, lines 7-13, Figure 1B, ref. 132.

¹⁰ See *id.* at, for example, page 5, lines 4-5.

¹¹ See *id.* at, for example, page 5, lines 6-7.

¹² See *id.* at, for example, page 5, lines 7-9.

¹³ See *id.* at, for example, page 18, lines 1-20, Figure 1B, ref. 136.

¹⁴ See *id.* at, for example, page 5, lines 9-11.

¹⁵ See *id.* at, for example, page 5, lines 11-12.

¹⁶ See *id.* at, for example, page 6, lines 18-19, Figure 1B, ref. 139.

¹⁷ See *id.* at, for example, page 23, line 17 to page 25, line 3, Figure 1C, ref. 160.

¹⁸ See *id.* at, for example, page 5, lines 13-14.

¹⁹ See *id.* at, for example, page 5, lines 16-18.

user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system;²⁰

at least one server for storing media,²¹ and having an associated third network address;
and

server software that receives a request, via the communication network,²² identifying one or more of the associated first, second, and/or third network addresses and authorization information,²³ and responds by identifying at least one other of the one or more of the associated first, second, and/or third network addresses to support the delivery of media to the at least one vehicle system.²⁴

Independent claim 14 recites the following:

A system providing support for the delivery of media to an authorized vehicle,²⁵ the system comprising:

a storage for storing media;²⁶

set top box circuitry²⁷ communicatively coupled to the storage,²⁸ the set top box circuitry arranged to exchange media via a communication network;²⁹

at least one vehicle system within the authorized vehicle remotely located from and communicatively coupled to the set top box circuitry,³⁰ the at least one vehicle system comprising an entertainment system;³¹

²⁰ See *id.* at, for example, page 19, lines 13-19, page 21, lines 1-3.

²¹ See *id.* at, for example, page 5, lines 13-14.

²² See *id.* at, for example, page 5, line 15.

²³ See *id.* at, for example, page 5, lines 18-20.

²⁴ See *id.* at, for example, page 5, line 20 to page 6, line 2.

²⁵ See *id.* at, for example, page 7, line 11 to page 8, line 2.

²⁶ See *id.* at, for example, page 7, lines 13-14.

²⁷ See *id.* at, for example, page 27, lines 7-13, Figure 1B, ref. 132.

²⁸ See *id.* at, for example, page 7, line 14.

²⁹ See *id.* at, for example, page 7, lines 16-17.

³⁰ See *id.* at, for example, page 7, lines 14-15.

³¹ See *id.* at, for example, page 6, lines 18-19, Figure 1B, ref. 139.

a user interface to support the delivery of media;³² the user interface having at least one view comprising graphical representations of media available for delivery to the at least one vehicle system;³³ the at least one view comprising a first personal media channel that facilitates a user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or handheld electronic game system;³⁴

at least one server for storing media;³⁵ and

server software that receives a request identifying a first network address and authorization information,³⁶ via the communication network, and responds by identifying a second network address to coordinate the delivery of media to the at least one vehicle system.³⁷

Independent claim 25 recites the following:

A method for delivering media to an authorized vehicle,³⁸ the method comprising:

selecting media for delivery based upon input from a user;³⁹

identifying a vehicle system comprising an entertainment system⁴⁰ to receive the selected media based upon input from the user;⁴¹

facilitating a transfer, via the vehicle system, of a video game from a source that is remote from the authorized vehicle to one or both of the entertainment system and/or a handheld electronic game system;⁴²

determining if the vehicle system is available to receive the selected media;⁴³

receiving authorization information from the vehicle system;⁴⁴

³² See *id.* at, for example, page 7, lines 17-18.

³³ See *id.* at, for example, page 7, lines 18-20.

³⁴ See *id.* at, for example, page 19, lines 13-19, page 21, lines 1-3.

³⁵ See *id.* at, for example, page 7, lines 20-21.

³⁶ See *id.* at, for example, page 7, line 22 to page 8, line 1.

³⁷ See *id.* at, for example, page 8, lines 1-2.

³⁸ See *id.* at, for example, page 9, lines 4-16, Figure 2.

³⁹ See *id.* at, for example, page 9, lines 5-7, page 25, lines 8-10.

⁴⁰ See *id.* at, for example, page 6, lines 18-19, Figure 1B, ref. 139.

⁴¹ See *id.* at, for example, page 9, lines 7-8, page 25, lines 12-22. .

⁴² See *id.* at, for example, page 19, lines 13-19, page 21, lines 1-3.

⁴³ See *id.* at, for example, page 9, lines 8-9.

⁴⁴ See *id.* at, for example, page 9, line 10.

verifying the authorization information;⁴⁵
delivering the selected media to the vehicle system if the verification is successful and the vehicle system is available to receive the selected media;⁴⁶ and
refraining from delivering the selected media to the vehicle system if the verification is not successful or the vehicle system is not available to receive the selected media.⁴⁷

Independent claim 31 recites the following:

A system providing support for the delivery of media to an authorized vehicle, the system comprising:

set top box circuitry⁴⁸ arranged to exchange media via a communication network,⁴⁹ wherein the set top box circuitry is coupled to at least one vehicle system⁵⁰ comprising an entertainment system,⁵¹ said set top box circuitry being remotely located from the authorized vehicle;⁵²

a user interface⁵³ having a view comprising a representation of a first personal media channel that facilitates a user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system;⁵⁴ and

software that receives a request identifying a network address and authorization information, via the communication interface,⁵⁵ and responds by coordinating the delivery of media to the at least one vehicle system.⁵⁶

⁴⁵ See *id.* at, for example, page 9, line 11.

⁴⁶ See *id.* at, for example, page 9, lines 11-14.

⁴⁷ See *id.* at, for example, page 9, lines 14-16.

⁴⁸ See *id.* at, for example, page 27, lines 7-13, Figure 1B, ref. 132.

⁴⁹ See *id.* at, for example, page 7, lines 16-17.

⁵⁰ See *id.* at, for example, page 18, lines 1-20, Figure 1B, ref. 136.

⁵¹ See *id.* at, for example, page 6, lines 18-19, Figure 1B, ref. 139.

⁵² See Figure 1B.

⁵³ See *id.* at, for example, page 6, lines 18-19, Figure 1B, ref. 139.

⁵⁴ See *id.* at, for example, page 19, lines 13-19, page 21, lines 1-3.

⁵⁵ See *id.* at, for example, page 5, line 15.

⁵⁶ See *id.* at, for example, page 8, lines 1-2.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(c)(1)(vi))

- Claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, 60, and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,799,201 (“Lee”) in view of U.S. 2004/0073932 (“Lavelle”).
- Claims 41, 47, and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Lavelle and U.S. 2004/0203379 (“Witkowski”).
- Claims 25-30, 52, 54, and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Lavelle and U.S. 2003/0097655 (“Novak”).
- Claim 53 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Lavelle, Novak, and Witkowski.

ARGUMENT
(37 C.F.R. § 41.37(c)(1)(vii))

The combination of Lee and Lavelle forms the basis for all the claim rejections. As explained below, however, the Office Action does not establish a *prima facie* case of obviousness with respect to the pending claims for a variety of reasons.

I. Requirements For A *Prima Facie* Case Of Obviousness

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Federal Circuit has stated that “**rejections on obviousness cannot be sustained with mere conclusory statements**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006), and *KSR Int’l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d at 1396 (quoting Federal Circuit statement with approval) (emphasis added).

Further, as specifically noted in the MPEP, “[t]o establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” *See* MPEP at 2143.03 (emphasis added). Further, “**[a]ll words in a claim must be considered** in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” *See id.* (emphasis added).

If a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. **If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**

See MPEP at § 2142 (emphasis added).

Additionally, “[i]f the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that ... claims are obvious.” See *In re Vaidyanathan*, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential) (attached).

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

With those principles in mind, the Applicants now turn to the claim rejections, in particular.

II. The Proposed Combination Of Lee And Lavelle Does Not Render Claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, 60, And 61 Unpatentable

The Applicants first turn to the rejection of claims 1-7, 9-18, 20-24, 31-34, 36-40, 42-46, 48-51, 56-58, 60, and 61 as being unpatentable over Lee in view of Lavelle.

A. Independent Claims 1, 14, And 31

Claim 1 recites, in part, “**set top box circuitry** communicatively coupled to the storage, ... the set top box circuitry **being remotely located from the authorized vehicle**; at least one vehicle system within the authorized vehicle **remotely located from and communicatively coupled to the set top box circuitry** via the second communication interface, ...a user interface to support the delivery of media, the user interface having at least one view comprising a representation of a sequence of media available for delivery to the at least one vehicle system, the at least one view comprising a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.**”

Thus, the claim is clear that the system includes **set top box circuitry** that is **remotely located from the vehicle** (that is, not within the vehicle), and a video game is transferred from

the set top box circuitry to the entertainment system within the vehicle system or a handheld game through the set top box circuitry. Independent claims 14 and 31 recite similar limitations.

The Office Action asserts that Lee discloses all the limitations of claim 1, except for “transfer of a video game to one or both of the entertainment system and/or a handheld electronic game system via the at least one vehicle system.” *See* September 1, 2010 Office Action at page 10.

Because the Office Action acknowledges that Lee does not disclose transfer of a video game via the vehicle system, the Office Action seemingly acknowledges that Lee cannot describe, teach or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.**”

1. Set Top Box Circuitry Remote From A Vehicle

The Applicants respectfully submit that the Office Action errs in assuming that Lee discloses “set top box circuitry,” as recited in claim 1.

Lee discloses a system that “consists of (1) a remotely programmable, microcomputer controlled multimedia device 20 in a vehicle with a wireless IP address for Internet access, (2) an Internet gateway network 30 that provides programming, information and Internet access to the multimedia device 20, and (3) one or more remote programming devices 40.” *See* Lee at column 6, lines 8-14 (emphasis added).

“Consists of” is a close-ended phrase. *See*, for example, MPEP at 2111.03

The Applicants note that reference numeral 30, which the Office Action relies on as “set top box circuitry” (*see* September 1, 2010 Office Action at pages 2 and 7) is an “Internet gateway network” (*see* Lee at column 6, line 11), but not set top box circuitry. Instead, the “gateway 30 serves as an Internet Service Provider to vehicles 184 through various forms of wireless transmission 186.” *See* Lee at column 11, lines 11-13.

A gateway that serves as an ISP is by no means set top box circuitry.

As the Applicants previously explained during prosecution, through evidentiary support, a television set-top box is different than, and includes functionality not found in, the internet gateway network of Lee. Indeed, the Microsoft Press Computer Dictionary, 3rd Edition,

at page 431 (previously provided), indicates that a “set-top box” is a “device that converts a cable TV signal to an input signal to the TV set.” It is also well known in the art that a “set-top box” is a device that converts a satellite TV signal to an input to the TV set.

There is nothing in Lee that describes, teaches, or suggests that the “Internet Gateway 30” connects to a television. Lee also does not describe, teach or suggest that the “Internet Gateway 30” connects to a “cable TV network,” or processes “cable TV signals,” or “satellite TV signals.” Again, the Internet Gateway 30 of Lee is by no means set-top box circuitry, as recited in the claims of the present application.

Notably, the Office Action does not respond to the definition of a set-top box provided by the Applicants. Instead, the Office Action simply provides a series of conclusory statements that the Internet Gateway 30 of Lee is somehow set-top box circuitry. *See* September 1, 2010 Office Action at pages 2-3. Thus, in response to the Applicants providing actual evidence as to the nature of a set-top box, the Office Action does not respond to the definition, but, instead, provides a series of conclusory statements that attempt to equate an “Internet Gateway [30]” and “Firewall through Internet (a communication Network)” as a set-top box remotely located from an authorized vehicle. *See id.*

As noted above, however, such an examination process clearly runs afoul of Federal Circuit case law.

KSR did not free the PTO’s examination process from explaining its reasoning. In making an obviousness rejection, the examiner should not rely on conclusory statements that a particular feature of the invention would have been obvious or is well known. Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion. Generally, the examiner cites prior art references to demonstrate the state of knowledge.

See In re Vaidyanathan, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

The Applicants respectfully submit that Federal Circuit case law, as well as the MPEP, prohibits the Examiner from making conclusions based on subjective understandings or experience, as the Examiner is attempting to do with respect to the limitations noted above. *See*

In re Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

As explained above, Lee does not describe, teach or suggest “set top box circuitry” remote from a vehicle and a vehicle system, in particular, or “set top box circuitry,” in general, as the Office Action contends. Thus, the Office Action has failed to demonstrate that the cited references expressly or necessarily describe, teach, or suggest “set top box circuitry communicatively coupled to the storage, the set top box circuitry arranged to exchange media via a communication network using a first communication interface, the set top box circuitry supporting wireless communication of media using a second communication interface, the set top box circuitry being remotely located from the authorized vehicle,” as recited in claim 1, “at least one vehicle system within the authorized vehicle remotely located from and communicatively coupled to the set top box circuitry, the at least one vehicle system comprising an entertainment system,” as recited in claim 14, or “set top box circuitry arranged to exchange media via a communication network, wherein the set top box circuitry is coupled to at least one vehicle system comprising an entertainment system, said set top box circuitry being remotely located from the authorized vehicle,” as recited in claim 31.

Thus, for at least these reasons, the Office Action fails to establish a *prima facie* case of unpatentability with respect to claims 1, 14, 31, and the claims depending therefrom.

2. Personal Channel Operative To Download A Video Game

Additionally, Lee does not describe, teach or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system.**”

Lee does not describe, teach or suggest a “**personal channel**” that is operative to download a “**video game.**” In fact, Lee makes only one reference to “game,” and that is in connection with an “interactive **audio** game.” *See* Lee at column 7, line 24 (emphasis added). Lee notes this as a “new personal information service” on the “multimedia device 20.” An

“interactive **audio** game” that is a “personal information service” is not the same as a “video game.”

Lavelle does not overcome the deficiencies of **Lee**. Instead, **Lavelle** discloses a “multimedia entertainment unit for use in a vehicle.” See **Lavelle** at [0001]. The unit may include a “video game player 126.” See *id.* at [0035]. The video game player may be part of, or input into, the entertainment unit. See *id.* at [0046]-[0047]. However, similar to the **Lee**, **Lavelle** does not describe, teach or suggest that video games are downloaded to the entertainment through an external source. Instead, **Lavelle** simply discloses that a video game player may be directly input to the entertainment unit, and games included on the player may then be played through the entertainment unit (*e.g.*, merely plugging a handheld game into the entertainment unit).

Lavelle at [0035] merely discloses a “display device 112” and a “video game player 126.” **Lavelle makes no mention of transferring games from outside the vehicle** to the “entertainment unit 100.” **Lee** also does not describe, teach, or suggest transferring video games from a remote source to a vehicle.

Neither **Lee**, nor **Lavelle**, describes, teaches, or suggests that video games are downloaded to the entertainment through an external source. Consequently, the combination of the two references cannot describe, teach, or suggest such a feature. Therefore, the proposed combination of **Lee** and **Lavelle** does not describe, teach, or suggest “a **first personal media channel** that facilitates a **user-defined transfer from the set top box circuitry [which is remote from the vehicle]**, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system,” as recited in claims 1, 14, and 31.

Thus, for at least these reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to claims 1, 14, 31, and the claims depending therefrom.

B. Claims 11, 22, And 38

Claim 11 depends from claim 9. Claim 9 recites, in part, “wherein the at least one vehicle system comprises an interface to at least one media peripheral.” Claim 11, which depends from

claim 9, recites, in part, “wherein the authorization information is supplied by the at least one media peripheral.” Claims 22 and 38 recite similar limitations.

The Office Action seemingly admits that Lee does not teach the subject matter of claim 9 from which claim 11 depends, by virtue of its reliance on Lavelle. *See* September 1, 2010 Office Action at page 13.

However, the Office Action asserts that “Lee further teaches wherein the authorization information is supplied by the at least one media peripheral (User profile databases 198 contains information about the user’s system preferences, billing information and a purchasing interest profile” *See id.* at page 13. Yet, the Office Action does not show that Lee teaches that the cited “Internet gateway network 30” containing “user profiles databases 198” is a “media peripheral” of the “vehicle multimedia receiver (20).” *Id.* at page 13.

In short, the Office Action fails to show where any of the cited references expressly or necessarily describes, teaches, or suggests “wherein the authorization information is supplied by the at least one media peripheral [that is interfaced to the at least one vehicle system].”

The Office Action provides the same reasoning with respect to claims 22 and 38. *See id.* at pages 14 and 16.

Thus, the Office Action has not demonstrated that the cited references describe, teach, or suggest “wherein the at least one vehicle system comprises an interface to at least one media peripheral ... wherein the authorization information is supplied by the at least one media peripheral,” as recited in claim 11, for example. For at least these additional reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to claim 11, 22, and 38.

C. Independent Claim 25

Independent claim 25 recites, in part, “facilitating a transfer, via the vehicle system, of a video game from a source that is remote from the authorized vehicle to one or both of the entertainment system and/or a handheld electronic game system.”

Lee does not describe, teach or suggest transferring a video game from a source that is remote from an authorized vehicle to one or both of a vehicle entertainment system and/or a handheld electronic game system. In fact, Lee makes only one reference to “game,” and that is in

connection with an “interactive audio game.” See Lee at column 7, line 24 (emphasis added). Lee notes this as a “new personal information service” on the “multimedia device 20.” An “interactive audio game” that is a “personal information service” is not the same as a “video game.”

Lavelle does not overcome these deficiencies of Lee. Lavelle discloses a “multimedia entertainment unit for use in a vehicle.” See Lavelle at [0001]. The unit may include a “video game player 126.” See *id.* at [0035]. The video game player may be part of, or input into, the entertainment unit. See *id.* at [0046]-[0047]. However, similar to the Lee, Lavelle does not describe, teach or suggest that video games are transferred to the entertainment through an external source. Instead, Lavelle simply discloses that a video game player may be directly input to the entertainment unit, and games included on the player may then be played through the entertainment unit (*e.g.*, merely plugging a handheld game into the entertainment unit).

Lavelle at [0035] merely discloses a “display device 112” and a “video game player 126.” **Lavelle makes no mention of transferring games from outside the vehicle** to the “entertainment unit 100.” Lee also does not describe, teach, or suggest transferring video games from a remote source to a vehicle.

Neither Lee, nor Lavelle, describes, teaches, or suggests that video games are transferred to the entertainment through an external source. Consequently, the combination of the two references cannot describe, teach, or suggest such a feature. Therefore, the proposed combination of Lee and Lavelle does not describe, teach, or suggest “facilitating a transfer, via the vehicle system, **of a video game from a source that is remote from the authorized vehicle** to one or both of the entertainment system and/or a handheld electronic game system,” as recited in claim 25.

Thus, for at least these reasons, the Office Action has not established a *prima facie* case of unpatentability with respect to claims 25 and the claims depending therefrom.

D. Dependent Claims 40, 46, And 58

Claim 40 recites, in part, “wherein the at least one vehicle system comprises a navigation system, the at least one view comprising a second personal media channel that facilitates a user-defined navigation update to the navigation system.” Claims 46 and 58 recite similar limitations.

The Office Action relies on Lee as disclosing these limitations. *See* September 1, 2010 Office Action at page 16. As explained below, however, such reliance is in clear error.

Lee discloses a “GPS receiver 110 that continuously reports the vehicles longitude, latitude and altitude.” *See* Lee at column 8, lines 60-61. “The vehicle 184 provides location information from its GPS receiver 110 (FIG. 2) to the gateway 30, and the gateway 30 in turn provides mapping services to the vehicle showing travel routes or locations of interest.” *See id.* at column 12, lines 14-20.

While Lee discloses location information from the GPS receiver and the gateway 30 providing mapping services, Lee does not describe, teach or suggest “a second **personal media channel** that facilitates a **user-defined navigation update** to the navigation system.” Lee simply does not describe, teach or suggest a user defining a navigation update, in general, or one through another personal media channel, in particular.

Lee does describe a user “manually request[ing] from the multimedia device 20 a recalibration of **local audio stations**” (*see id.* at column 15, lines 21-26), but requesting recalibration of local audio stations is by no means a request by the user for a navigation update. Instead, the recalibration is merely directed to local radio stations for listening pleasure.

The Office Action fails to demonstrate that any of the cited references expressly or necessarily describes, teaches, or suggests “wherein the at least one vehicle system comprises a navigation system, the at least one view comprising a second personal media channel that facilitates a user-defined navigation update to the navigation system,” as recited in claim 40, for example. Thus, for at least these additional reasons, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of unpatentability with respect to claims 40, 46, and 58.

E. Obviousness Guidelines

Moreover, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Federal Circuit has stated that ‘rejections on obviousness **cannot be sustained with mere conclusory statements**.’ *See* MPEP at § 2142 (emphasis added).

“If the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If **there is neither record evidence nor detailed examiner reasoning**, the Board should not conclude that ... claims are obvious.” See *In re Vaidyanathan*, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential) (emphasis added).

“[W]hile *KSR* relaxed some of the formalism of earlier decisions requiring a ‘teaching, suggestion, or motivation’ to combine prior art references, it did not remove the need to anchor the analysis in explanation of how a person of ordinary skill would select and apply the teachings of the references.” See *id.* at page 17. Moreover,

KSR did not free the PTO’s examination process from explaining its reasoning. In making an obviousness rejection, **the examiner should not rely on conclusory statements that a particular feature of the invention would have been obvious or is well known.** Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion. **Generally, the examiner cites prior art references to demonstrate the state of knowledge.**

Id. (emphasis added).

Referring to the PTO’s published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite **seven rationales** supporting an obviousness rejection and give specific findings that **must be made** by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are **not optional and must be articulated by the Examiner for the rationale to apply.** The seven rationales are listed below.

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

MPEP at § 2141.

The Office Action is unclear as to which Rationale it uses to reject the claims. Further, the Office Action seemingly does not provide **all** of the **required** factual findings.

Therefore, if the current rejection is maintained, the Applicants respectfully request that the Examiner’s Answer: 1) **identify the specific Rationale** (i.e., by **specifically indicating one of A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejection so that the Applicants may more clearly address the Examiner’s concerns, and 2) **state on the record the required** factual findings to support the Rationale that the Examiner has chosen.⁵⁷

“It is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in KSR and discussed in the 2007 KSR Guidelines, they are to adhere to the instructions provided in the MPEP regarding the **necessary** factual findings.” *See* September 1, 2010 Examination Guidelines Update (emphasis added).

⁵⁷ Indeed, the Applicants respectfully request such an explicit analysis and associated factual findings for **each and every rejection** under 35 U.S.C. § 103 of any of the pending claims, as required by current PTO practice.

“Simply stating the principle ... without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness.” *See id.*

Further, it is “Office policy that appropriate factual findings are required in order to apply the enumerated rationales properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel must either withdraw the rejection, or repeat the rejection including all the required factual findings.” *See id.* (emphasis added).

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

III. The Proposed Combination Of Lee, Lavelle, And Witkowski Does Not Render Claims 41, 47, And 59 Unpatentable

The Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claims 41, 47, and 59 for at least the reasons set forth above with respect to claims 1, 14, and 31.

IV. The Proposed Combination Of Lee, Lavelle, And Novak Does Not Render Claims 25-30, 52, 54, And 55 Unpatentable

The Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claims 25-30, 52, 54, and 55 for at least the reasons set forth above with respect to claims 1, 14, and 31.

Additionally, the Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claim 52 for at least the reasons set forth above with respect to claims 40, 46, and 58.

V. The Proposed Combination Of Lee, Lavelle, Novak, And Witkowski Does Not Render Claim 53 Unpatentable

The Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to claim 53 for at least the reasons set forth above with respect to claim 25.

VI. CONCLUSION

For at least the reasons discussed above, the Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-7, 9-18, 20-34, and 36-61.

VII. PAYMENT OF FEES

The Commissioner is authorized to charge any necessary fees, including the \$130 fee for the one-month extension and the \$540 fee for this Appeal Brief, or credit any overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: February 17, 2011

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CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(1)(viii))

1. A system providing support for the delivery of media to an authorized vehicle, the system comprising:

a storage for storing media, and having an associated first network address;

set top box circuitry communicatively coupled to the storage, the set top box circuitry arranged to exchange media via a communication network using a first communication interface, the set top box circuitry supporting wireless communication of media using a second communication interface, the set top box circuitry being remotely located from the authorized vehicle;

at least one vehicle system within the authorized vehicle remotely located from and communicatively coupled to the set top box circuitry via the second communication interface, the at least one vehicle system having an associated second network address, the at least one vehicle system comprising an entertainment system;

a user interface to support the delivery of media, the user interface having at least one view comprising a representation of a sequence of media available for delivery to the at least one vehicle system, the at least one view comprising a first personal media channel that facilitates a user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system;

at least one server for storing media, and having an associated third network address; and

server software that receives a request, via the communication network, identifying one or more of the associated first, second, and/or third network addresses and authorization information, and responds by identifying at least one other of the one or more of the associated first, second, and/or third network addresses to support the delivery of media to the at least one vehicle system.

2. The system of claim 1 wherein the media comprises one or more of audio, a still image, video, real-time video, and/or data.

3. The system of claim 1 wherein the media comprises one or more of navigational information, information related to commercial broadcasters, software, travel routing information, information related to vehicle performance, and/or vehicle service information.
4. The system of claim 1 wherein one or more of the associated first, second, and/or third network addresses is an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN).
5. The system of claim 1 wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure.
6. The system of claim 1 wherein the communication network is the Internet.
7. The system of claim 1 wherein the second communication interface comprises one or both of an infrared link and/or a radio frequency link.
8. (Canceled)
9. The system of claim 1 wherein the at least one vehicle system comprises an interface to at least one media peripheral.
10. The system of claim 9 wherein the at least one media peripheral comprises one or more a digital camera, a digital camcorder, a television, a personal computer, a CD player, a multi-media gateway device, a multi-media personal digital assistant, a DVD player, a tape player, and/or a MP3 player.
11. The system of claim 9 wherein the authorization information is supplied by the at least one media peripheral.
12. The system of claim 1 wherein the authorization information comprises a digital certificate comprising one or more of a device ID, a public key for encryption, information

related to services, information regarding payment terms, information regarding billing, and/or media push/access restrictions and limitations.

13. The system of claim 1 wherein the at least one server supports one or more of media storage, third party media services, the provision of third party media, and/or the exchange of media.

14. A system providing support for the delivery of media to an authorized vehicle, the system comprising:

- a storage for storing media;

- set top box circuitry communicatively coupled to the storage, the set top box circuitry arranged to exchange media via a communication network;

- at least one vehicle system within the authorized vehicle remotely located from and communicatively coupled to the set top box circuitry, the at least one vehicle system comprising an entertainment system;

- a user interface to support the delivery of media, the user interface having at least one view comprising graphical representations of media available for delivery to the at least one vehicle system, the at least one view comprising a first personal media channel that facilitates a user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or handheld electronic game system;

- at least one server for storing media; and

- server software that receives a request identifying a first network address and authorization information, via the communication network, and responds by identifying a second network address to coordinate the delivery of media to the at least one vehicle system.

15. The system of claim 14 wherein the media comprises one or more of audio, a still image, video, real-time video, and/or data.

16. The system of claim 14 wherein the data comprises one or more of navigational information, information related to commercial broadcasters, software, travel routing information, information related to vehicle performance, and/or vehicle service information.

17. The system of claim 14 wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure.
18. The system of claim 14 wherein the communication network is the Internet.
19. (Canceled)
20. The system of claim 14 wherein the at least one vehicle system comprises an interface to at least one media peripheral.
21. The system of claim 20 wherein the at least one media peripheral comprises one or more a digital camera, a digital camcorder, a television, a personal computer, a CD player, a multi-media gateway device, a multi-media personal digital assistant, a DVD player, a tape player, and/or a MP3 player.
22. The system of claim 20 wherein the authorization information is supplied by the at least one media peripheral.
23. The system of claim 14 wherein the authorization information comprises a digital certificate comprising one or more of a device ID, a public key for encryption, information related to services, information regarding payment terms, information regarding billing, and/or media push/access restrictions and limitations.
24. The system of claim 14 wherein the at least one server supports one or more of media storage, third party media services, the provision of third party media, and/or the exchange of media.
25. A method for delivering media to an authorized vehicle, the method comprising:
 - selecting media for delivery based upon input from a user;
 - identifying a vehicle system comprising an entertainment system to receive the selected media based upon input from the user;

facilitating a transfer, via the vehicle system, of a video game from a source that is remote from the authorized vehicle to one or both of the entertainment system and/or a handheld electronic game system;

determining if the vehicle system is available to receive the selected media;

receiving authorization information from the vehicle system;

verifying the authorization information;

delivering the selected media to the vehicle system if the verification is successful and the vehicle system is available to receive the selected media; and

refraining from delivering the selected media to the vehicle system if the verification is not successful or the vehicle system is not available to receive the selected media.

26. The method of claim 25 wherein the media comprises one or more of audio, a still image, video, real-time video, and/or data.

27. The method of claim 25 wherein the selecting and identifying are performed via a user interface having at least one view comprising a graphical representation of media available for delivery to the at least one media peripheral.

28. The method of claim 25 wherein the authorization information is conveyed as a digital certificate comprising one or more of a device ID, a public key for encryption, information related to services, information regarding payment terms, information regarding billing, and/or media push/access restrictions and limitations.

29. The method of claim 25 wherein the receiving and delivering are performed using a wireless communication link.

30. The method of claim 29 wherein the wireless communication link comprises one or both of an infrared link and/or a radio frequency link.

31. A system providing support for the delivery of media to an authorized vehicle, the system comprising:

set top box circuitry arranged to exchange media via a communication network, wherein the set top box circuitry is coupled to at least one vehicle system comprising an entertainment system, said set top box circuitry being remotely located from the authorized vehicle;

a user interface having a view comprising a representation of a first personal media channel that facilitates a user-defined transfer from the set top box circuitry, via the at least one vehicle system, of a video game to one or both of the entertainment system and/or a handheld electronic game system; and

software that receives a request identifying a network address and authorization information, via the communication interface, and responds by coordinating the delivery of media to the at least one vehicle system.

32. The system of claim 31 wherein the media comprises one or more of audio, a still image, video, real-time video, and/or data.

33. The system of claim 31 wherein the media comprises one or more of navigational information, software, travel routing information, information related to vehicle performance, and/or vehicle service information.

34. The system of claim 31 wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure.

35. (Canceled)

36. The system of claim 31 wherein the at least one vehicle system comprises an interface to at least one media peripheral.

37. The system of claim 36 wherein the at least one media peripheral comprises one or more of a digital camera, a digital camcorder, a television, a personal computer, a CD player, a multi-

media gateway device, a multi-media personal digital assistant, a DVD player, a tape player, and/or a MP3 player.

38. The system of claim 36 wherein the authorization information is supplied by the at least one media peripheral.

39. The system of claim 31 wherein the authorization information comprises a digital certificate comprising one or more of a device ID, a public key for encryption, information related to services, information regarding payment terms, information regarding billing, and/or media push/access restrictions and limitations.

40. The system of claim 1, wherein the at least one vehicle system comprises a navigation system, the at least one view comprising a second personal media channel that facilitates a user-defined navigation update to the navigation system.

41. The system of claim 40, wherein the navigation system collects vehicle route, performance and engine maintenance information with respect to the authorized vehicle and uploads the vehicle route, performance and engine maintenance information to one or both of the set top box circuitry and/or the at least one server.

42. The system of claim 40, wherein the at least one vehicle system comprises a music system and a video system, the at least one view comprising a third personal media channel that facilitates a user-defined transfer of a song to the music system and a fourth personal media channel that facilitates a user-defined transfer of a movie to the video system.

43. The system of claim 1, wherein the at least one view comprises at least one friends and family channel.

44. The system of claim 1, wherein the at least one view comprises at least one 3rd party broadcast media channel.

45. The system of claim 9, wherein the at least one media peripheral offloads media data to the vehicle system.

46. The system of claim 14, wherein the at least one vehicle system comprises a navigation system, the at least one view comprising a second personal media channel that facilitates a user-defined navigation update to the navigation system.

47. The system of claim 46, wherein the navigation system collects vehicle route, performance and engine maintenance information with respect to the authorized vehicle and uploads the vehicle route, performance and engine maintenance information to one or both of the set top box circuitry and/or the at least one server.

48. The system of claim 46, wherein the at least one vehicle system comprises a music system and a video system, the at least one view comprising a third personal media channel that facilitates a user-defined transfer of a song to the music system and fourth personal media channel that facilitates a user-defined transfer of a movie to the video system.

49. The system of claim 20, wherein the at least one media peripheral offloads media data to the vehicle system.

50. The system of claim 14, wherein the at least one view comprises at least one friends and family channel.

51. The system of claim 14, wherein the at least one view comprises at least one 3rd party broadcast media channel.

52. The method of claim 25, comprising scheduling a navigation update based on a user-defined trip to the navigation system of the authorized vehicle.

53. The method of claim 52, comprising collecting vehicle route, performance and engine maintenance information with respect to the authorized vehicle and uploading the vehicle route, performance and engine maintenance information to one or both of set top box circuitry and/or said a server.

54. The method of claim 25, comprising: facilitating transfer of music to a music system of the authorized vehicle; and facilitating transfer of a movie to a video system of the authorized vehicle system.

55. The method of claim 25, comprising offloading media content from a media peripheral to the vehicle system.

56. The system of claim 31, wherein the view comprises at least one friends and family channel.

57. The system of claim 31, wherein the view comprises at least one 3rd party broadcast media channel.

58. The system of claim 31, wherein the view comprises a second personal media channel that facilitates a user-defined navigation update to a navigation system of the vehicle system.

59. The system of claim 57, comprising a vehicle navigation system that collects vehicle route, performance and engine maintenance information with respect to the authorized vehicle and uploads the vehicle route, performance and engine maintenance information to the set top box circuitry.

60. The system of claim 57, wherein the view comprises a third personal media channel that facilitates a user-defined transfer of a song to a music system of the vehicle system and a fourth personal media channel that facilitates a user-defined transfer of a movie to a video system of the vehicle system.

61. The system of claim 1, wherein the at least one view comprises at least one friends and family channel.

EVIDENCE APPENDIX
(37 C.F.R. § 41.37(c)(1)(ix))

- (1) Microsoft Press Computer Dictionary, 3rd Ed., page 431, entered into record by Applicants with November 19, 2009 Pre-Appeal Brief Request for Review.
- (2) U.S. 6,799,201 (“Lee”), entered into record by Examiner in February 17, 2009 Office Action.
- (3) U.S. 2004/0073932 (“Lavelle”), entered into record by Examiner in February 17, 2009 Office Action.
- (4) U.S. 2004/0203379 (“Witkowski”), entered into record by Examiner in October 31, 2007 Office Action.
- (5) U.S. 2003/0097655 (“Novak”), entered into record by Examiner in October 31, 2007 Office Action.

RELATED PROCEEDINGS APPENDIX
(37 C.F.R. § 41.37(c)(1)(x))

As of the filing date of this Appeal Brief, the Applicants are not aware of any decisions that have been rendered with respect to any of the Appeals noted in the Related Appeals and Interferences Section.